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Patent and Trademark Office

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06/614,923	05/29/84	GROHE	K BAYER-5844

SPRING, HORN, KRAMER & WOODS  
600 THIRD AVE,  
NEW YORK, NY 10016

EXAMINER	
TURNIFSEED, J	
ART UNIT	PAPER NUMBER
129	8
DATE MAILED 7/13/85	

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined  Responsive to communication filed on \_\_\_\_\_  This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), \_\_\_\_\_ days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

<input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892.	<input type="checkbox"/> Notice re Patent Drawing, PTO-948.
<input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449	<input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152
<input checked="" type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474	<input type="checkbox"/> _____

Part II SUMMARY OF ACTION

1.  Claims 1-34 are pending in the application.

Of the above, claims 32-34 are withdrawn from consideration.

2.  Claims \_\_\_\_\_ have been cancelled.

3.  Claims 5 and 12-15 are allowed.

4.  Claims 1-4 and 16-31 are rejected.

5.  Claims 6-11 are objected to.

6.  Claims \_\_\_\_\_ are subject to restriction or election requirement.

7.  This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.

8.  Allowable subject matter having been indicated, formal drawings are required in response to this Office action.

9.  The corrected or substitute drawings have been received on \_\_\_\_\_. These drawings are  acceptable;  not acceptable (see explanation).

10.  The  proposed drawing correction and/or the  proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_ has (have) been  approved by the examiner.  disapproved by the examiner (see explanation).

11.  The proposed drawing correction, filed \_\_\_\_\_, has been  approved.  disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.

12.  Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has  been received  not been received

been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.

13.  Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14.  Other

The references supplied by applicants have been made of record.

The requirement is made for the insertion of the status of the applications cited on page 1 of the specification.

Claims 1-34 remain in this case.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-31, drawn to compounds, composition, method of use and method of preparation, classified in Class 544, subclass 362.

II. Claim 32, drawn to a quinoline compound, classified in Class 546, subclass 156.

III. Claims 33 and 34, drawn to ethyl esters of acyclic acids, classified in Class 560, subclass 51.

The inventions are distinct, each from the other, because of the following reasons:

Inventions I and II-III are related as species in an intermediate-final product relationship.

Distinctness is proven for claims in this relationship if the intermediate product is useful other than to make the final product (MPEP 806.04(b), 3rd paragraph), and the species are patentably distinct. (MPEP 806.04(h)).

In the instant case, the intermediate product is deemed to be useful as antibacterial agents with respect to group II and insecticides with respect to group III and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants.

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Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103 of the other invention.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized diverse subject matter restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Joseph G. Kolodny on December 4, 1985 and December 5, 1985, a provisional election was made with traverse to prosecute the invention of group I, claims 1-31. Affirmation of this election must be made by applicant in responding to this Office action. Claims 32-34 stand withdrawn from further consideration by the examiner as being drawn to a nonelected invention. See 37 CFR 1.142(b).

The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious

at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

The factual inquiries set forth in Graham v. John Deere Co. that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are summarized as follows:

1. Determining the scope and contents of the prior art;
2. Ascertaining the differences between the prior art and the claims at issue; and
3. Resolving the level of ordinary skill in the pertinent art.

Graham v. John Deere Co., 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467 (1966).

Claims 16-23 are again rejected under 35 U.S.C. 103 as being unpatentable over Matsumoto, et al. for the reasons given in the last Office Action.

The arguments advanced by applicants have been considered but are not found to be persuasive. It is not seen how the presence of the cyclopropyl radical in the 1-position on the bicyclic ring system would influence the course of the reaction as appears to be urged by applicants.

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Matsumoto, et al. clearly teach the reaction of an amine with a halide as employed in the instant claims to obtain a product analogous to those of the instant claims. Therefore it would be obvious for one of skill in the art to substitute the starting materials as employed in the instant claims into the process as disclosed by Matsumoto et al. to obtain the products of the instant claims.

Claims 1-4 and 16-31 are rejected under 35 U.S.C. 112, first and second paragraphs, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are indefinite and read on compounds not finding adequate support in the disclosure.

There is no adequate showing that compounds reading on the phrase "mono- or bi-cyclic N-, O- or S- heteroaryl" have been prepared and would possess the disclosed utility. The phrase read on compounds having indefinite ring sizes and the number and positions of the hetero atoms are not shown.

OK The phrase "if appropriate" renders the claims indefinite since the claims should define what the invention is, not what is appropriate. Further, there

is not teaching of when it would be appropriate to take the  $R^1$  and  $R^2$  together to form a further heterocyclic ring.

The phrase "a further hetero atom" renders the claims indefinite and readable on compounds not finding adequate support in the disclosure since there is no teaching of what the other hetero atom may be and since there is no adequate showing that all known hetero atoms may be employed in forming compounds reading on the instant claim terminology.

The phrase "and which can furthermore possess a double bond" renders the claim indefinite since it cannot be seen how an aryl ring system can contain a double bond.

The term "polysubstituted" renders the claims indefinite and readable on compounds not finding adequate support in the disclosure since the term reads on compounds where all available sites are substituted, however, there is no adequate showing in the disclosure that said compounds have been prepared and would possess the disclosed utility properties.

The definition of  $R^4$  as employed in claim 3 renders the claims indefinite and readable on compounds not finding adequate support in the disclosure since the terminology employed is so broad and indefinite that one of skill in the art would not be able to determine the metes and bounds of the claims.

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It is suggested that the claim terminology be limited to read on compounds finding adequate and effective support in the disclosure.

Claims 6-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 5 and 12-15 are allowed.

Claims 32-34 stand withdrawn.

Any inquiry concerning this communication should be directed to Examiner JH Turnipseed at telephone number 703-557-3920.

*JHT*  
JH Turnipseed:pw

A/C 703

557-3920

12/2/85

*GH*  
GLENNON H. HOLLRAH  
SUPERVISORY PATENT EXAMINER  
ART UNIT 129

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